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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,107	02/13/2001	Mihal Lazaridis	555255012189	3129

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RESEARCH IN MOTION
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EXAMINER	
STRANGE, AARON N	

ART UNIT	PAPER NUMBER
2153	

MAIL DATE	DELIVERY MODE
01/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/782,107	LAZARIDIS ET AL.	
	Examiner	Art Unit	
	Aaron Strange	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *90-95,97-102 and 104-109* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *90-95,97-102 and 104-109* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Examiner would like to note that the present application has been reassigned to a new Examiner.

2. In the interest of expedited prosecution, the Examiner would like to recommend conducting an interview prior to filing a response to the present Office action. The Examiner feels that an interview would be beneficial in identifying potentially allowable subject matter and/or issues for appeal. If Applicant agrees that an interview would be beneficial, he/she is encouraged to contact the Examiner to schedule one.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification makes no reference to the term "computer-accessible medium", which appears in claims 105-109. Applicant must amend the specification to provide clear support or antecedent basis for the term, taking care to ensure that no new matter is introduced.

Double Patenting

4. Applicant has failed to adequately traverse the double patenting rejection set forth in the Office action of 7/3/2007. Accordingly, the double patenting rejection is maintained. Since the amended claims contain similar subject matter to those

previously rejected, the rationale set forth in the Office action of 7/3/2007 remains applicable and will not be repeated here.

Response to Arguments

5. Applicant's arguments filed 10/30/2007 have been fully considered but they are not persuasive.

6. With regard to claim 1, and Applicant's assertion that Airmobile does not teach or suggest "configuring the user's mail address as the reply mail item's originating address" (Remarks, 17), the Examiner respectfully disagrees.

Airmobile clearly discloses that all messages sent using the Airmobile system are configured with the user's mail address as the reply mail item's originating ("From:") address (messages are configured with "From:" address such as Mitch Hansen @99999999)(p. 38). It is also noted that these messages contain the same "From:" address when they are received (p. 39), which is additional evidence that the messages retain this originating address throughout the sending process.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 99-102 and 104 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Claims 99-102 and 104 recite a system claim comprising a plurality of "means for" performing various functions. The specification of the present application discloses that redirector program performs these functions (Specification, 4-8). Since the redirector program is a software program, the disclosure would have suggested to one of ordinary skill in the art that the claimed means are intended to include-only embodiments. Since the claim is not limited to statutory subject matter, it is non-statutory.

Additionally, it is noted that claims 105-109 contain limitations directed to a "code portion for" performing the same functionality as that claimed in claims 99-102 and 104. When considered in combination with the language of claims 99-102 and 104 and the content of the specification, these provide further evidence that the claimed means are intended to include software per se.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 90-95, 97-102 and 104-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile Server (AirMobile Wireless Software for Lotus cc:Mail, Communication Server Guide, Motorola, 1995), in view of AirMobile Client (AirMobile Wireless Software for Lotus cc:Mail, Communication Client Guide, Motorola, 1995), and Carthy et al. (MAPI Developers Forum post "MAPI Notification" April 12, 1996; hereinafter Carthy) further in view of Eggleston et al. (U.S. Patent No. 5,764,899, hereinafter "Eggleston") further in view of Murota (U.S. Patent No. 6,289,105).

Note, the AirMobile Server and AirMobile Client guide present different aspects of the same system, and are therefore are treated as a single system for the purposes of this rejection. They are hereinafter referred to with specific citations to the Server guide as "AirMobileS" and the Client guide as "AirMobile."

12. With regard to claim 90, AirMobile disclosed a method of redirectinginformation between a messaging host system ("communication server") and a wireless mobile data device that is associated with a computer (i.e. the mobile device in AirMobile is in and of itself a computer) connected over a network to the messaging host system (p. 9,

"Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication server, and the mail account is associated with a mobile device according the device ID), the method comprising:

- receiving a notification at a redirector component indicating receipt of a mail item for a user by the messaging host system, wherein the user data item is addressed to a mail address of the user (i.e., Gene Eggleston@88888888 or Mitch Hansen@99999999)(p. 38-39) that is associated with the messaging host system and is viewable via the computer (e.g. Airmobile pushes received messages to the mobile clients and this push algorithm is invoked by some internal notification; see inter alia pgs 30 and 31 "enables messages to be immediately downloaded when they are received"];
- processing the mail item at the redirector component to add address information associated with the wireless mobile data device (required for delivery to the mobile client, see pg 31 ¶s 1-3);
- sending the mail item from the redirector component to the wireless mobile data device over a wireless network (the actual push or download of the message to the mobile device pg 31, ¶s 1-3).
- receiving a reply mail item from the wireless mobile data device at the redirector component (e.g. sending reply to the server pg 38);
- interfacing the reply mail item to the messaging host system by the redirector component such that the reply mail item is sent to the sender (e.g. forwarding the reply to the original sender, pg 38) wherein the user's mail address is

configured as the reply mail item's originating address (i.e., message from Mitch Hansen uses "Mitch Hansen@99999999" as the "From:" address).(p. 38-39).

Given AirMobile's disclosure that the AirMobile software allows users to connect to their cc:Mail server "back in the office", one of ordinary skill in the art would have recognized that mail messages could be sent, received, or replied to, exactly the way they could be on a conventional email system, and that the appropriate addressing information would appear in the "To:" and "From:" headers of the messages.

While Airmobile discloses substantial potions of the claimed invention (discussed above), it fails to specifically recite 1) that the *notification* is *automatically generated* in response to receipt of the user data item, 2) transmitting a *copy* of the received electronic message and 3) using encryption for sending messages between the redirector component and the mobile data device.

With regard to point (1), AirMobile failed to specifically recite that the *notification* is *automatically generated* in response to receipt of the user data item. AirMobile disclosed a server side push technology (pg 31 ¶ 1-3), where the server must internally poll for the arrival on new messages in a user's mailbox. Nonetheless Examiner maintains that such an automatic notification must occur in the system in order for the actual forwarding software to be invoked within the computer system. Furthermore even if one were to argue persuasively that such a notification is not inherent then

Examiner maintains that adding a new data item automatic notification feature would have been an obvious modification to AirMobile at the time of Applicant's invention, in view of at least Carthy. In a similar art, Carthy disclosed an e-mail system where the notification of new messages in a user's mailbox is sent **automatically,** as opposed to polling, using an extended MAPI IMAPIadviseSink notification (See the Carthy post describing "full asynchronous" notification in extended MAPI). Carthy further disclosed that in order to receive these automatic notifications the system must register with a software interface associated with the messaging server (i.e. registering with the ImsgStore to receive adviseSinks). Cathy also disclosed that automatic notification is preferable to polling (see the Cohen post below: "Today I do a polling on each mailbox : I open a connection through MAPI functions, I consult, I notify if new mail, and I close the connection. Then I go to the next mailbox and do the same actions. It's not great ☹. So I'd like to know whether –there- exists another way to notify with MAPI, especially a "fully asynchronous" notification"). Automatic notification is preferable to polling for detecting the arrival of new messages since the detection process is more efficient. For example the system no longer has the delay associated with polling each user's mailbox and is instead alerted immediately of the arrival of new messages. Additionally less system resources are consumed since the system no longer has to poll the mailbox of each user in order to detect new messages. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the automatic notification functionally disclosed by Carthy within AirMobile's system, since Carthy disclosed automatic notification is preferable to polling and further since the use of

automatic notification is more efficient. Again automatic notification is more efficient since the system is alerted immediately of the arrival of new messages and less system resources are consumed.

With regard to point (2), AirMobile discloses forwarding messages received at the messaging server to the wireless device. However, AirMobile does not *explicitly* state that the messages forwarded to the wireless mail system are a *copy*. Nonetheless, most e-mail systems that forward messages actually replicate the messages before forwarding, so that a copy of the message is retained in the initial destination mailbox. Such replication is disclosed by Eggleston. In a similar art, Eggleston teaches a system for forwarding messages from a LAN-based host through a wireless host to a mobile client device, wherein the LAN-based host stores messages, thereby maintaining a replica of the messages, before forwarding them to the client (col. 4, lines 44-51; col. 12, lines 32-39, 59-62, wherein the messages are copied and maintained at a host system, and are also sent to target units). Thus, given the teaching of Eggleston, a person having ordinary skill in the art would have readily recognized the desirability and advantages of replicating the messages at the messaging server taught by AirMobile, to preserve received messages in case the client memory fails or the message is lost in transmission. Therefore, it would have been obvious to include the mail replication feature taught by Eggleston in the mail forwarding system taught by AirMobile and Carthy.

With regard to point (3), AirMobileS disclosed sending messages from the cc:Mail server to the mobile device in a secure fashion (AirMobileS, p. 25, bullet 1 "secure and authenticated virtual wireless communication channel between your laptop and your LAN-based cc:Mail server") however, AirMobile does not disclose using encryption for sending messages in a secure fashion. Nonetheless the use of encryption to send messages securely was widely known in the art at the time of Applicant's invention, as evidenced by at least Murota. In a similar email system, Murota disclosed encrypting e-mail messages between a sender and a receiver, wherein a message is encrypted at the sending end, is then transmitted over the network to the receiving end, and is finally decrypted at the receiving computer (col. 1, lines 23-48). Murota further disclosed that such an encryption scheme is advantageous because it prevents leaks of secret information to outside, non-intended parties (Murota, col. 1, lines 49-53). Thus, given the teaching of Murota, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention include an encryption function, as taught by Murota, in conjunction with the redirector component of AirMobile such that messages sent between the AirMobile server and mobile devices are encrypted, in order to prevent outside parties from having access to secret or classified messages.

With regard to claim 91, AirMobile disclosed the redirector component is operating on the messaging host system (pg 9 "communication server" and pg 31 ¶s 1-3).

13. With regard to claim 92, AirMobile disclosed the redirector component is operating on a host system that is couple to the message host system via the network (e.g. the Network fiel server cc:Mail Postoffice works in tandem with the Windows AirMobile server pg 9).

14. With regard to claim 93, Eggleston disclosed that messages sent between the wired and wireless systems can be compressed (col. 11, lines 63-67). Given this knowledge, it would have been obvious to a person having ordinary skill in the art to compress the messages in the system taught by AirMobile, Carthy, Bezaire, and Eggleston, prior to transmission to the gateway, and to decompress the messages at the mobile device, as suggested by Eggleston, in order to increase available bandwidth and to provide faster and less expensive communications (see Eggleston, col. 12, lines 7-9).

15. With regard to claim 94, AirMobile disclosed the processing step further comprises encoding the copy of the user data item (e.g. transforming a message into the required transmission protocol for the wireless network being utilizing prior to pushing a message to the user) (additionally compressing as set forth with regard to claim 106 is a form of encoding).

With regard to claim 95, Examiner takes official notice that the Multipurpose Internet Mail Extensions protocol was widely known and used to communicate email messages between devices at the time of Applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to encode messages using the MIME protocol within AirMobile's system in order to communicate messages between devices using a known reliable protocol.

16. With regard to claim 97, AirMobile disclosed the step of sending the copy of the user data item from the redirector component to the wireless mobile data device over the wireless network further comprises sending the copy of the user data item via a wireless gateway disposed between a wide area network and the wireless network (see pg 9, Figure 1-1, a gateway is required to interface between the networks).

17. With regard to claim 98, AirMobile disclosed the step of storing the user data item at the data store associated with the messaging host system (p. 9, "Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication server, and the mail account is associated with a mobile device according the device ID).

18. Claims 99-102 and 104-109 are rejected under the same rationale as claims 90-95, 97 and 98, since they recite substantially identical subject matter. Any differences

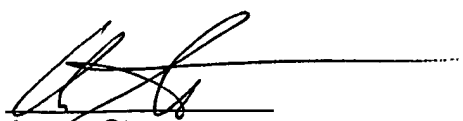
between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Aaron Strange
GAU 2153
1/22/2008